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09/704,022	11/01/2000	David Roy Kendall	TS-7568 (US)	2088

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EXAMINER	
TOOMER, CEPHIA D	
ART UNIT	**PAPER NUMBER**
1714	4

DATE MAILED: 01/30/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

T-D-4

BEST AVAILABLE COPY

Office Action Summary

Application No.	Applicant(s)	
Examiner	Group Art Unit	

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL.**

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 1 1; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 1-22 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-22 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☐ All ☐ Some* ☒ None of the:

☒ Certified copies of the priority documents have been received.

☐ Certified copies of the priority documents have been received in Application No. _____.

☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____.

Attachment(s)

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☒ Notice of Reference(s) Cited, PTO-892

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Interview Summary, PTO-413

☐ Notice of Informal Patent Application, PTO-152

☐ Other _____

Office Action Summary

DETAIL ACTION

Specification

The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> **The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.**

1. Claims 1-6, 9-11, 15 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is rejected because the claim lacks proportions. In the absence of proportions, the metes and bounds of the claim cannot be determined.

claims 2,9,15 and 20 are rejected because thee is no antecedent support for "the weight ratio".

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fuentes-Afflick (US 6,203,584).

Fuentes-Afflick teaches a fuel additive comprising at least one amine group wherein the amine may be of the formula R_3NH-$(R_4$-$NH)_n$-H wherein R_3 is hydrocarbyl having a number average molecular weight of about 700 to 3000. The compound reads on the amines of the present invention when R_3 is as stated above and n is 0 (see col. 7, lines 52-61). The hydrocarbyl group may be a polyisobutenyl or polyisobutyl group (see col. 4, lines 20-23). The composition may also contain another amine such as a hydrocarbyl polyoxyalkylene aminocarbamate containing at least one basic nitrogen atom and having an average molecular weight of about 500 to 10, 000. The hydrocarbyl group contains from 1 to 30 carbon atoms (see col. 9, lines 44-58; col. 10, lines 7-16).

Fuentes-Afflick teaches that the additives are present in a fuel in amounts from about 50 to 5000 ppm (see col. 13, lines 12-16). The fuel may also contain conventional additives (see col. 13, lines 43-50) and the examiner takes Official notice that the claimed corrosion inhibitors are conventional fuel additives. Fuentes-Afflick teaches the limitations of the claims other than the differences that are discussed below.

Fuentes-Afflick differs from the claims in that he does not specifically teach the presence of both amines or the claimed ratio. However, it would have been obvious to one of ordinary skill

in the art to have used both amines because Fuentes-Afflick teaches that at least one amine may be used and this suggests that more than one amine could be present in the composition. Furthermore, it is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose. *In re Kerkhoven*, 205 USPQ 1069 (CCPA 1980).

It would have been obvious to one of ordinary skill in the art to have prepared the additive with the amines in the claimed weight ratio because it is not inventive to determine the optimum ratio by routine experimentation.

Claims 1-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over W09112303.

WO teaches a fuel composition comprising a fuel additive comprising a hydrocarbyl poly(oxyakylene) aminocarbamate having at least one basic nitrogen and an average molecular weight of about 1000 to about 3,000 and a branched-chain hydrocarbyl amine having at least one basic nitrogen and an average molecular weight of about 300 to about 700 (see page 10, lines 3-15). The fuel composition comprises about 400-1200 ppm of the fuel additive (se page 10, lines 22-25). The hydrocarbyl group of the poly (oxyalkylene) aminocarbamate has from 1 to 30 carbon atoms (see page 13, lines 09-32). The hydrocarbyl moiety of the branched-chain amine is derived from olefin polymers such as polyisobutylene (see page 17, lines 29-30; page 18, lines 3-5). The amine may be a monoamine (see page 18, lines 16-17). The fuel composition will contain about 100 to 225 ppm aminocarbamate and about 10 to 70 ppm amine.. The proportions encompass the claimed weight ratio.

WO also teaches that the fuel may contain conventional additives (see page 22, lines 11-19). The examiner takes Official Notice that the claimed corrosion inhibitors are conventional fuel additives and that it would have been obvious to one of ordinary skill in the art to have included the corrosion inhibitor to perform its attendant function.

WO teaches the limitations of the claims other than the molecular weight of the hydrocarbyl amine. However, a prima facie case of obviousness exist where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties. *Titanium Metals Corp. v. Banner*, 227 USPQ 773 (Fed. Cir. 1985). WO teaches that the amine has a molecular weight of about 300 to about 700. About 700 clearly reads on or is close enough to the claimed 750 to render the claimed molecular weight to be obvious.

Any inquiry concerning this communication should be directed to Cephia D. Toomer at telephone number (703) 308-2509.

Toomer/af

January 15, 2002

Cephia D. Toomer

Patent Examiner-1714